UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,796	09/18/2001	Ed O. Schlotzhauer	10010804-1	1044

7590	04/04/2006	EXAMINER

AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P.O. Box 7599
Loveland, CO 80537-0599

EXAMINER
WEST, JEFFREY R

ART UNIT	PAPER NUMBER
2857	

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED <u>17 March 2006</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

   a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.

   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

   (a)☐ They raise new issues that would require further consideration and/or search (see NOTE below);

   (b)☐ They raise the issue of new matter (see NOTE below);

   (c)☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d)☐ They present additional claims without canceling a corresponding number of finally rejected claims.

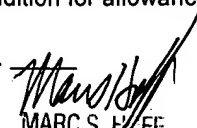   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: _____.

   Claim(s) withdrawn from consideration: _____.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>See Continuation Sheet.</u>

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.

13. ☐ Other: _____.

MARC S. HUFF
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800

Applicant first argues:
"In the response to arguments, the examiner maintains that the variation point is a point in a test sequence execution. This suggests that the variation point is a point in time. However, in claims 1 and 21 a variation point is defined as a point in a computer program at which call instruction is inserted. This defines the variation point is a location in a computer program, not a point in time. Further, the call instruction is inserted by the designer, before execution, rather than during execution. In Grey (and Perez), the test sequence is the computer program that controls the measurement process, and the test sequence is created by the user. The test executive is part of the architecture through which the test sequence exerts its control."

The Examiner asserts that that the variation point is not a point in time but, as stated in the previous Office Action, is "a point in the test sequence execution in which a function call passes control to a user-defined variation function" which is consistent with the definition provided by Applicant of "a variation point is defined as a point in a computer program at which [a] call instruction is inserted". Perez/Grey specifically discloses this variation point in Grey, column 13, lines 50-58 and column 14, lines 52-61:
"Most steps in a TestStand sequence invoke code in another sequence or in a code module. When invoking code in a code module, TestStand must know the type of the code module, how to call it, and how to pass parameters to it. The different types of code modules include LabVIEW VIs, C functions in DLLs, and C functions in source, object, or library modules that are created in LabWindows/CVI or other compilers. TestStand also must know the list of parameters that the code module requires." (Grey; column 13, lines 50-58)
"In TestStand, the values of variables and properties can be used in numerous ways, such as passing a variable to a code module or using a property value to determine whether to execute a step. Sometimes the user desires to use an expression, which is a formula that calculates a new value from the values of multiple variable or properties. An expression can be used anywhere a simple variable or property value is used. In expressions, the user can access all variables and properties in the sequence context that is active when TestStand evaluates the expression." (column 14, lines 52-61)

Applicant then argues:
"In claims 1 and 21, the user is prevented from modifying the measurement process other than through the user-defined variation process. Grey teaches away from this aspect of the claims, since in the Grey reference it is the user who defines the measurement process through the test sequence. In particular, Grey describes the test executive as having a Sequence Editor specifically to allow the user to modify the test sequence (and thereby modify the measurement process). Rather than preventing the user from modifying the measurement process other than through user defined variation points, the test executive of Grey provides a sequence editor specifically to allow the user to modify the measurement process without restriction."

The Examiner asserts that it has been held that "[a]rguments that the alleged anticipatory prior art is nonanalogous art or teaches away from the invention or is not recognized as solving the problem solved by the claimed invention, [are] not germane to a rejection under section 102." Twin Disc, Inc. v. United States, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting In re Self, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)). >See also State Contracting & Eng ' g Corp. v. Condotte America, Inc., 346 F.3d 1057, 1068, 68 USPQ2d 1481, 1488 (Fed. Cir. 2003).

Applicant argues:
"The examiner relies on Perez column 4, lines 52-65 to argue that the user is prevented from modifying the measurement process other than through the user-defined variation function. Perez column 4, lines 52-65 describes child test sequences derived from a base test sequence. However, Perez column 3, lines 16-25 describes how the base test sequence is manually created by the user. It is clear that the user is not prevented from modifying the base sequence. Further, column 3, lines 38-51, describes how the user can manually edit the child test sequences. It is clear that the user is not prevented from modifying the child test sequences. Applicant submits Perez teaches away from the inventions of claim 1 and claim 21, since it teaches that the computer program that controls the measurement process (i.e. the test sequence or the child test sequence) may be manually edited by the user."

The Examiner asserts that the invention of Perez does disclose an embodiment wherein the user is able to modify the child test sequences. The Examiner also asserts, however, that Perez also discloses an embodiment wherein the user is prevented from modifying the child test sequences, specifically,
"It is noted that various alternative embodiments of the method described above are contemplated. For example, in one embodiment the method may not store actual test sequences in response to the base test sequence, but may instead store information regarding each child test sequence, such that the child test sequence can be programmatically created each time the child test sequence is to be executed. For example, the stored information may comprise meta-information specifying how each child test sequence differs from the actual base test sequence. Storing and manipulating this type of meta-information (e.g., as opposed to actual test sequence files) may enable greater flexibility in the allowed modifications to a child test sequence without breaking the association between a base test sequence and a child test sequence." (column 4, lines 49-63)

"The functionality described above may be implemented in any of various ways in various embodiments. In one embodiment, it may be useful or necessary to maintain an association between the base test sequence and each child test sequence. The association between the base test sequence and each child test sequence may be "locked", wherein the locking prevents the user from editing the child test sequence in various ways. For example, in one embodiment the user may be allowed to change a parameter configuration for a step in a child test sequence, but may not be allowed to add a new step to the child test sequence without breaking the association between the base test sequence and the child test sequence. For example, in various implementations it may be necessary to prevent the user from editing a child test sequence in certain ways, so that the child test sequence is structured in a well-known way or is in a known state and can thus be automatically updated in response to changes made to the base test sequence as described above. If necessary, the user may need to override the allowed editing policies in order to configure a certain child test sequence as desired. However, doing so may cause the association between the base test sequence and the child test sequence to be broken or removed, such that the child test

sequence can no longer be automatically updated. (column 10, line 57 to column 11, line 14).

Therefore, while Perez does disclose embodiments for allowing test sequence modification, since Perez also discloses embodiments for preventing test sequence modification, Perez anticipates the claims. Further, in addition to the above-noted holding that "[a]rguments that the alleged anticipatory prior art is nonanalogous art or teaches away from the invention or is not recognized as solving the problem solved by the claimed invention, [are] not germane to a rejection under section 102," it has also been held that "Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971)."

Applicant argues:
"Further, claims 1 and 21 call for the computer program that controls the measurement process to contain variation points inserted by a designer (not the user). The examiner refers to Grey et al. column 12, lines 41-53. Here Grey describes how sequences contain steps that can call external code modules. As discussed above, the sequences are specified by the user, not by the designer (as called for in claims 1 and 21), so any calls to external code modules are inserted by the user. Further, this is contrary to other remarks by the examiner that identified the test executive as being equivalent to the computer program of claims 1 and 21."
The Examiner asserts that, as noted above, the invention of Grey/Perez differentiates between a "user" that is designing the test sequence which would, for example, set the association between the base test sequence and each child test sequence to be "locked" for preventing the user from editing the child test sequence in various ways, and the end "user" that is executing the test sequence and is the one being prevented from editing the child test sequence.
Therefore, while Grey refers to the test designer as a "user" as well as the end-user as a "user", one having ordinary skill in the art would recognize that the "user" that is inserting the function calls is a "designer" while the "user" that is using the function calls during execution is the actual program "user". Therefore, the section of column 12, lines 41-53 refers to the program design and the associated "user" is actually a designer.

Applicant further argues:
"The Perez and Grey references describe a test executive system of the type described on page 2, line 16, to page 3, line 9, of the specification for the present invention. In particular, the references describe systems in which the user is free to create a complete test procedure through definition of the sequence of steps. The present invention provides for a user to modify a process without requiring the user to understand the complete process. The process itself is determined by the designer of the program. The user may make variations to the process without the risk of invalidating the process itself. In contrast, in the systems of Perez and Grey, there are no constraints to prevent a user from defining an invalid process."
The Examiner asserts that the claims do not specifically require constraints to prevent a user from defining an invalid process, but only from modifying the measurement process, and the invention of Perez does disclose providing constraints to prevent a user from modifying the measurement process other than through the user-defined variation function, specifically:
"in one embodiment the method may not store actual test sequences in response to the base test sequence, but may instead store information regarding each child test sequence, such that the child test sequence can be programmatically created each time the child test sequence is to be executed. For example, the stored information may comprise meta-information specifying how each child test sequence differs from the actual base test sequence. Storing and manipulating this type of meta-information (e.g., as opposed to actual test sequence files) may enable greater flexibility in the allowed modifications to a child test sequence without breaking the association between a base test sequence and a child test sequence." (column 4, lines 50-63)

"In one embodiment, it may be useful or necessary to maintain an association between the base test sequence and each child test sequence. The association between the base test sequence and each child test sequence may be "locked", wherein the locking prevents the user from editing the child test sequence in various ways. For example, in one embodiment the user may be allowed to change a parameter configuration for a step in a child test sequence, but may not be allowed to add a new step to the child test sequence without breaking the association between the base test sequence and the child test sequence." (column 10, line 58 to column 11, line 2).